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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/645,376	08/24/2000	Michael Scott Probasco	NC13977	3555

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Nokia Inc
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EXAMINER

CALLAHAN, PAUL E

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/645,376	Applicant(s) PROBASCO	
	Examiner Paul Callahan	Art Unit 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1-3 and 6 is/are allowed.
6) ☒ Claim(s) 4,5 and 7-14 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-14 are pending and have been examined.

Response to Arguments

2. Applicant's arguments with respect to Claims 1-14 have been considered but are only partially persuasive.

The arguments presented by the Applicant with regards to Claims 1, 6, 8 and 11, when taken together with the changes made to the language of the Claims via the latest amendment, are successful in overcoming the rejections of the Claims as found in the previous Office Action.

The Applicant's arguments in traverse of the rejection of Claims 9 and 10 as found in the previous Office Action is persuasive and the rejection is withdrawn.

The Applicant's argument in traverse of the rejection of Claim 4 is not persuasive. The Applicant asserts that the invention of Claim 4 may be distinguished from the teachings of Wasilewski because "neither the Wasilewski '474 patent nor either of the other cited references teaches or suggests any comparison between a hashed representation of a pre-stored key and a hashed key included in a broadcast message, as recited by independent Claim 4." Yet a review of the Wasilewski patent: (see especially col. 4 lines 12-22 and col. 11 lines 24-30) does indeed teach this feature.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10 and 11 are rejected under 35 U.S.C. 101 because the Claimed invention is directed to non-statutory subject matter.

As for Claim 10, the Claim is directed towards an electromagnetic data signal and hence is a judicial exception to the four statutory classes of invention eligible for the grant of a US Patent. Section 101 of title 35, United States Code, provides: *Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.* The Claimed subject matter is directed towards matter falling under a Judicial Exception to 35 USC Sec. 101, namely an abstract idea, law of nature, or natural phenomenon.

From the United States Patent and Trademark Office Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility:

In examining Claims for subject matter eligibility, the Examiner is directed to:

Determine Whether the Claimed Invention is a Practical Application of an Abstract Idea, Law of Nature, or Natural Phenomenon Sec. 101 Judicial Exceptions)

For Claims including such excluded subject matter to be eligible, the Claim must be for a practical application of the abstract idea, law of nature, or natural phenomenon. Diehr, 450 U.S. at 187, 209 USPQ at 8 ("application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection."); Benson, 409 U.S. at 71, 175 USPQ at 676 (rejecting formula Claim because it "has no substantial practical application").

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To satisfy section 101 requirements, the Claim must be for a practical application of the Sec. 101 judicial exception, which can be identified in various ways:

- *The Claimed invention "transforms" an article or physical object to a different state or thing.*
- *The Claimed invention otherwise produces a useful, concrete and tangible result.*

Claim 10 does not meet the standard to be a practical application of the Judicial Exception since it does not cause a physical transformation. There is no Claim limitation recited that is directed towards a receiver or antenna to obtain the electromagnetic signal and cause it to direct a processor or allow the signal to be stored in a physical memory. By this same argument no concrete or tangible result can be found since the electromagnetic signal does not act on a physical object absent a receiver or antenna.

As for Claim 11, the Claim is directed to a computer program, yet there is no recitation of a limitation directed towards a computer-readable memory medium that stores the instruction set. Therefore the Claim is directed towards non-statutory subject matter since it is a mere arrangement of data in the abstract. The program cannot be a practical application of a Judicial exception to 35 USC 101 since it cannot transform any physical article or produce any concrete or tangible result without being embodied in a memory medium such that it can be read out by a processor and direct it to undertake steps coded for by the program. Claim 12 is dependent on Claim 11 and is thereby rejected on the same basis as is that Claim.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more Claims particularly pointing out and distinctly Claiming the subject matter which the Applicant regards as his invention.

6 Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly Claim the subject matter which Applicant regards as the invention. The Claims are each directed towards a computer readable memory. Yet there is no limitation in either Claim directed towards a computer program stored in the memory. As recited in the Claims, the memory is a mere storage location with no instruction set stored therein that would direct a processor to undertake the steps coded for by the instruction set. The Claims therefore fail to distinctly Claim the subject matter of the intended invention since such a program is necessary to cause the processor to undertake the steps found in the other Claim limitations. Claim 13 is dependent on Claim 9 and is therefore rejected on the same basis as is that Claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 4, 5, 7, and 14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wasilewski et al. US 5,870,474.

As for Claim 4, Wasilewski teaches a method and means for carrying out the method for decrypting a message received over a broadcast network (abstract) comprising the steps of: receiving data comprising an encrypted message and a hashed key at a node in said broadcast network (abstract) where said node comprises means for storing data (fig. 1 items 90a – 90n “Customers STU’s”); parsing said data to derive said encrypted message and said hashed key (col. 11 lines 24-30); comparing said received hashed key with a plurality of keys pre-stored in said means for storing data in said node and to select a key having a hash matching said received hashed key and decrypting said encrypted message with said matching key if a match is found (col. 11 lines 24-67).

As for Claim 5, Wasilewski teaches requesting a key from a network entity if no pre-stored key has a hash that matches said received key (col. 11 lines 48-50).

As for Claim 7, Wasilewski teaches a network entity that distributes hashed keys col. 4 lines 12-22 and col. 11 lines 24-30.

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As for Claim 14, Wasilewski teaches parsing, comparing, and decrypting steps that are carried out at each of a plurality of nodes (col. 11 lines 24-67)

Allowable Subject Matter

9. Claims 1-3 and 6 are allowed.

10. Claims 8 and 9 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

11. Claim 13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base Claim and any intervening Claims.

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Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 1pm to 10pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

7-6-06

Paul Callahan

A handwritten signature in black ink, appearing to read "Paul Callahan", written in a cursive style.